In the Supreme Court
OF THE
United States

Supreme Court, U. S.
FILED
SEP 6 1940
CHARLES ELMORE CROPLEY
CLERK

OCTOBER TERM, 1940

No. 401

GROVER D. TURNBOW, C. E. GRAY and LEDERLE LABORATORIES, INC. (a corporation),
Petitioners,

vs.

FARMERS' COOPERATIVE EXCHANGE, INC., (a corporation),
Respondent.

PETITION FOR WRIT OF CERTIORARI
to the United States Circuit Court of Appeals
for the Ninth Circuit,
and
BRIEF IN SUPPORT THEREOF.

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PETITION FOR WRIT OF CERTIORARI
to the United States Circuit Court of Appeals
for the Ninth Circuit.

(NOTE): All emphasis herein ours, unless otherwise specified.

To the Honorable Charles Evans Hughes, Chief Justice of the United States, and to the Associate Justices of the Supreme Court of the United States:

Your petitioners, Grover D. Turnbow, C. E. Gray, as individuals, and Lederle Laboratories, Inc., a Delaware corporation, respectfully pray for a writ of certiorari to the United States Circuit Court of Appeals for the Ninth Circuit to review a judgment entered by that Court on April 22, 1940 (111 F.(2d) 728), reversing the judgment and decree of the United States District Court for the Northern District of California, Southern Division (unreported).

A petition for rehearing was filed on May 22, 1940, and denied by memorandum order of the Court on June 11, 1940.

In conformity with Rule 38 of this Court a certified copy of the record, including the proceedings in the Ninth Circuit Court of Appeals, accompanies this petition.

SUMMARY STATEMENT OF MATTERS INVOLVED.

Originally there were two suits by petitioners against respondents, on two separate patents, as follows:

The first suit was for infringement of Lindstaedt patent No. 2,036,638, of April 7, 1936, application filed June 15, 1929, for "Parasiticide";

The second was predicated on infringement of Turnbow patent No. 2,091,840, of August 31, 1937, application filed September 30, 1930, for "Vermifuge".

The actions were tried in the District Court for the Northern District of California, upon an order of consolidation and upon a single record (1 R. 117).*

The District Court found all claims in issue of both patents to be valid and infringed (Decress, 1 R. 137, 1 R. 188).

Whilst respondent-defendant appealed from each lower Court decree, the Circuit Court of Appeals treated the causes as one, and rendered a single judgment. Therefore, the same procedure is followed here, and a single consolidated title is used.

Both patents are directed to "composition of matter",** known as parasiticides or vermifuges, for internal use, particularly in poultry, whereby destruction of such internal parasites as roundworms commonly infesting portions of the intestinal tract of poultry may be accomplished efficiently and without risk of the life of the fowl.

The Lindstaedt patent disclosed that substances of **colloidal nature** (for instance hide-glue, casein, peanut meal, soy bean meal, agar-agar, starch, and many others) will render normally-lethal quantities of **alkaloidal toxic substances** (such as nicotine, coniine, etc.) non-lethal, upon ingestion of the same by animals, when the toxic substances are absorbed by, and adsorbed on, the colloidal substances; and that the bond thus created between the alkaloidal toxic substance and the colloid, was such as to hold or maintian the toxic

*In record reference, the first numeral designates the volume of the record, the second number designates the page.

**For the Patent Statutes here involved, see Appendix A.

substance non-lethal during the passage of the compound through that portion of the digestive tract when if released it would kill the animal, but will permit the release of the toxic substance in active form in the digestive tract of an animal at the point inhabited by parasites sought to be destroyed, and would thereupon destroy the parasites without injury to the fowl or other animal treated. This release occurs because the admixture is undisturbed in an acid medium, such as found in the alimentary canal of an animal and in that part of the intestinal tract preceding the habitat of the parasites, but is broken down, to release the toxic substance in active form, in the alkaline medium present in the intestines where the parasites are located.

Lindstaedt disclosed at least **nine** members of the class of **toxic substances** which were suitable for the purpose, and disclosed a wide range (no less than **fourteen** members) of the class of **colloidal substances** which would serve to carry out the invention. The patentee further disclosed exact proportions, in terms of milligrams of each ingredient, required to produce the parasiticide sought.*

The Turnbow Patent taught the production of a finely divided—comminuted—form of parasiticide or vermifuge, having the chemical ingredients and characteristics earlier taught by Lindstaedt, and which could be mixed with the feed for "flock feeding", thus overcoming any necessity for manual administration or pellets or the like.

*See Appendix B for a fu ther resumé of the patent.

That the Appellate Court had no difficulty in expressing its understanding of the meaning of the term "colloid" as used in the patents is seen at the outset of their opinion (5 R. 1561), where it was said:

> "Without attempting to state technically the exact meaning of a colloid, it is sufficient here to say that a colloid is a substance which attaches to other material and which prevents the latter material from acting in the manner that it would in its free state. It is generally believed that colloidal action takes place either by adsorption or absorption, or both. Adsorption is described as the addition of a film of one substance over the surface of another, such as a film of oil over metal, and absorption is described as the filling of the pores of one material with another, such as the absorption of water by a sponge."

There is no question but that the proofs conclusively show that the advent of these inventions solved, satisfactorily for the first time, an important problem for the poultry industry, and the trial judge, who saw the witnesses and heard the evidence, so found (see Findings (1 R. 119-134), Nos. 7-17, inclusive, and 26).

In the instant case, the Circuit Court of Appeals for the Ninth Circuit held all of the claims to be invalid by virtue of the fact that since all the claims fall in the general class commonly referred to as "chemical claims", some, but not all, of said claims were directed to an admixture of ingredients which were specified by

"class", and that a patentee could not make a generic claim for a class unless he could show affirmatively that every member of that class would work.

That, we submit, contravenes established law.

They also, and, we submit, erroneously, further held that the proportions of some of such ingredients were delimited in terms of result or function* and that therefore the entire patent was void.

The Court of Appeals did not pass upon the question of infringement, nor did it consider anticipation, other than to summarize the state of the art to the point of entrance of the Lindstaedt invention in the commercial field.

THE BASIS OF THIS APPLICATION FOR WRIT.

These cases present squarely the important, unsettled and troublesome question of sufficiency (or insufficiency) of description, and of so-called "indefinite" claims, in **chemical or "composition of matter" patents,** concerning which there have been numerous conflicting and confusing decisions in the several circuits. The principles governing the proper

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*Plaintiffs stood on claims 2, 3, 6, 8, 11 and 12 of the Lindstaedt Patent, and claims 1, 2 and 7 of the Turnbow Patent. Typical of said claims were:

Lindstaedt Claim 8: "A non-lethal parasticide for internal administration for intestinal parasites, comprising the combination of a nicotine substance in a dose normally parasiticidal to said parasites, and lethal to the subject being treated on ingesting the same alone, and an organic colloid, said organic colloid rendering said dose non-lethal to the subject being treated, and leaving it parasiticidal to said parasites."

Turnbow Claim 2: "A medicinal compound in finely divided condition comprising agar-agar, and nicotine substance, said compound being non-toxic to fowls when given in quantities sufficient to destroy parasites of the intestinal tract."

form and substance of chemical claims has never been adequately fixed by decisions of this Court so as to enable the Patent Office, the inventor, the public, or the Courts to determine within reasonable limits when such a claim is sufficient.

The effect of the judgment of the Appellate Court in the instant cases is to undermine the generally accepted rules of interpretation of chemical claims and to create a new rule to the effect: that a chemical "class" can not be secured by a patent claim **despite the fact that a wide number of the members of the class are named in the specification of each patent and shown to be operative for the purpose in hand, and despite the fact that no member of the class has been shown to be inoperative for the ascribed purpose!**

Nevertheless, that Honorable Court announced the dictum **(without any showing of any kind that there existed any colloids that would not work)** (5 R. 1570):

> "There are a great many alkaloidal substances, and Lindstaedt and Turnbow, could not, by the simple expedient of claiming a compound of alkoloidal substances and colloidal substances, obtain a monopoly of a countless number of compounds, which could be made from these immense classes of substances."

We know of no rule which says that mere numbers alone in a class bar the claiming of a class.

No member of either class, disclosed or undisclosed, is shown by the record or in the opinion of the Circuit Court of Appeals to be inoperative for the inventor's purpose.

We respectfully submit that the established rule is (and this record is consistent with the rule) that whereas one may not as a general proposition, on discovering a **single compound which is active for a particular purpose, claim all compounds which are thus active,** nevertheless where there has been a generic discovery, as here, and **a large number of examples of ingredients capable of use in the compound are shown, as here,** and where there is no testimony to the contrary, and where it is not shown that there are some ingredients of the class incapable of such use, that it is permissible to have both generic and specific claims in the same patent.*

The Appellate Court here then continues (5 R. 1571):

> "It is clear, therefore, that what, if anything, was novel, was the discovery of how much colloidal material was necessary to carry out the function of preventing the alkaloidal substance from having a lethal effect on the subject to which the product was administered. * * *
>
> "We may assume, without so deciding, that the claims sufficiently describe the quantity of the alkaloidal substance. The quantity of colloidal substance is described only as being an amount sufficient to colloidally hold and protect against the lethal effect of the dose. Such is the exact function of the colloidal material." (5 R. 1571.)

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*"There is nothing improper * * * in first putting your claims as broadly as in good faith you can, and then * * * following them successively with narrower claims designed to protect you against possible anticipations of which you are not yet aware." *Parke-Davis and Co. v. H. K. Mulford Co.*, 189 Fed. at 102. Affirmed, 196 F. 496 (2 C.C.A.).

If that is the known function then it is difficult to see where any indefiniteness comes in.

The Court went on to say (5 R. 1571):

> "The claims here violate that rule, and are void because 'conveniently functional language at the exact point of novelty' is used. Gen. Electric Co. v. Wabash Co., supra, 371. See also: Wood v. Underhill et al., 46 U.S. (5 How.) 1, 4; The Incandescent Lamp Patent, 159 U.S. 465, 474."

And in conclusion (5 R. 1572):

> "The instant case is one illustrative of the practice followed in many patents. The inventors experimented with and compounded particular alkaloidal substances with particular colloidal substances. Instead of confining their claims to that which they actually discovered, if anything, they attempted to monopolize all parasiticides which could be made from the entire class of alkaloidal substances with the entire class of colloidal substances. We think the patent law is not so benevolent, and although we do not base our decision on that express ground, we mention it to refute suggestions that the issuance of a patent offers no protection to a patentee."

We submit that the Appellate Court's mass destruction of the valuable class of chemical and composition-of-matter patents is more to the public detriment than was the **upholding of that single patent** which this Court eventually found invalid in *General Electric Co. v. Wabash Co.*, 304 U.S. 364, and upon which the Appellate Court in the instant case predicated its decision. The *General Electric* case and the instant one stand on vastly different grounds as is shown post.

If that Honorable Court's view concerning generic claims in chemical cases is correct and that only claims for specific compounds may legally be obtained, then it would require every inventor of a new chemical compound to go through the entire class and test out every substance in that class, and then attempt to take out a separate patent for each combination of ingredients!

Recognizing the difficulty of any such analysis and exhaustive study or investigation, and the utter futility of acquiring adequate patent protection if the above formula was attempted to be followed, a negative rule has been set up both by the Courts and by the Patent Office to the effect that: **a generic claim is not available or permissive where it is affirmatively shown that certain members of the class will not work.** See *Incandescent Lamp* case, 159 U.S. 465; *Corona v. Dovan,* 276 U.S. 358.

No point is made by petition of the fact that no weight was given by the Circuit Court to the uncontroverted evidence of the commercial success enjoyed by the product of the patents in suit, except merely to add that it was shown as an undisputed fact that within three years after the appearance of the Lindstaedt product on the market, the sales of the prior art products had decreased to a point where petitioners' products enjoyed substantially all of the business in parasiticides and have virtually driven the prior art products from the market (table, 3 R. 1133). Ordinarily such circumstances warrant at least favorable notice. *Eibel Process Co. v. Paper Co.,* 261 U.S. 45.

QUESTIONS PRESENTED.

Upon the facts there is presented a situation wherein an inventor has discovered broadly that substances of colloidal nature will render normally lethal doses of toxic substances non-lethal, and still leave them in condition to act as parasiticides upon ingestion; the inventor going on to disclose in his patent examples, in exact terms of quantity, of products which may be employed to produce the desired result: and defining numerous members of each class—toxic substances and colloidal substances—which have been found to be satisfactory to carry out his fundamental teaching; and that none of such members are shown to be inoperative for the intended purpose:

QUERY 1. Upon such facts, can it be said that the law of the land is such that the inventor is not entitled to claim generically his invention, but must confine himself to claiming the invention only in terms of the specific substances with which he has actually worked, and in proportions only which he has actually found to be satisfactory for treatment of each of the innumerable species of the animal kingdom?

QUERY 2. Upon these facts, can it be said that the discoverer is not entitled to claim his invention in generic terms, there being no showing in the record that, prior to the work of Lindstaedt, anyone had discovered that substances of colloidal nature possessed the property of adsorbing and absorbing toxic substances in a manner to render a normally lethal dose of the latter non-lethal, while still leaving it in a form conditioned to be released where it is needed

to exert its parasiticidal value, and without the use of a capsule or like protective covering?

QUERY 3. Can it be said, further, as a broad rule, as has been done by the Ninth Circuit Court of Appeals, that chemical ingredients can not be claimed as a class, when there is not shown to be known to exist any exceptions to successful use of any member of the class?

QUERY 4. Inasmuch as the Circuit Court of Appeals for the Ninth Circuit, in addition to invalidating the claims of the patents in suit for failure to claim the inventions in terms of "specific ingredients" with which each of the inventors worked, likewise ruled that the claims were void for definition of the quantities or proportions of the ingredients in functional language or in terms of result, rather than by statement of mathematical quantities or proportions:

Is the ruling of the Ninth Circuit Court that chemical claims must define the quantities or proportions of ingredients in non-functional language—inferentially, in mathematical terms—correct, on a set of facts such as here presented; or may an inventor define the quantity or proportion of the ingredients in terms of desired results?

QUERY 5. Where the claims of a patent for a chemical combination of known substances specify the relation and character of those substances with such definiteness as is reasonable under the conditions encountered in the art to which the patent relates, do such claims comply with U.S.R.S. 4886 and 4888 (U.S.C.A. Title 35, Sections 31 and 33), even though

the specifications must be referred to for the proportions and relations of the substances employed; and particularly when the specifications are sufficient and specify the limits within which the ingredients are used; and when the Patent Office found said specifications sufficient; and when the defendant (as one "skilled in the art")* followed the patent teachings and found no difficulty in producing a commercial, competitive article?

ASSIGNMENT OF ERRORS.

The errors which petitioner will urge, if this writ of certiorari is granted, are that the Circuit Court of Appeals for the Ninth Circuit erred:

1. In holding that an inventor of a new composition of matter may not validly claim his invention in generic language.

2. In holding that chemical ingredients may not be claimed as a class, where numerous members of the class are named in the patent, and where none of such members so mentioned, nor any other members of the class, are shown to be inoperative for the purpose desired.

3. In holding that "a limited use of terms of effect or result which accurately defines the essential qualities of a product to one skilled in the art" is not permissible in chemical or composition claims, even when coupled with the designation and use of the

*Note the statutory requirement of R. S. 4888 (see Appendix A), providing for "a written description * * * in such full, clear, concise and exact terms **as to enable any person skilled in the art** or science to which it appertains", etc.

elements effective for such result, as set out in the claims of the patents in suit, thereby contravening established patent law as exemplified, for instance, by the following cases:

General Electric Co. v. Wabash Co., 304 U.S. 364, 371;

Holland Furniture Co. v. Perkins Glue Co., 277 U.S. 245, 257.

4. In deciding an important question of general law in a way that is in conflict with the weight of authority.

5. In deciding an important question of patent law contrary to the weight of authority uniformly established through the decisions of this Court and other Courts for the past ninety years or more, as illustrated by the following cases:

Wood v. Underhill, 5 How. 1;

Smith v. Goodyear Dental Vulcanite, 93 U.S. 486;

Tilghman v. Proctor, 102 U.S. 707;

Cochrane v. Badische Anilin and Soda Fabrik, 111 U.S. 293;

Seabury v. Ende, 152 U.S. 561;

The Incandescent Lamp Patent, 159 U.S. 465;

Minerals Separation Ltd. v. Hyde, 242 U.S. 261;

Eibel Process Co. v. Paper Co., 261 U.S. 45;

Temco Electric Motor Co. v. Apco Manufacturing Co., 275 U.S. 319;

Corona Cord Tire Co. v. Dovan Chemical Corp., 276 U.S. 358;

Holland Furniture Co. v. Perkins Glue Co., 277 U.S. 245;

General Electric Co. v. Wabash Co., 304 U.S. 364;

Zittlozen v. Boss, 219 F. 887 (8 C.C.A.);

General Electric Co. v. P. R. Mallory & Co., 298 F. 579 (2 C.C.A.);

Douglas Pectin Corp. v. Armour & Co., 27 F. (2d) 814 (2 C.C.A.);

Allen Filters Co. v. Star Metal Mfg. Co., 40 F. (2d) 252 (3 C.C.A.);

Sun Ray Corp v. Bellows-Claude Neon Co., 49 F.(2d) 886 (6 C.C.A.);

Research Corp. v. Chase, 88 F.(2d) 353 (7 C.C.A.);

Research Products Co. v. Tretolite Co., 106 F. (2d) 530 (9 C.C.A.).

6. In reversing the decree below and holding the claims void for indefiniteness and insufficiency, in the absence of any evidence whatever to support such conclusions.

Wherefore your petitioners respectfully pray that a writ of certiorari be issued under the seal of this Court directed to the United States Circuit Court of Appeals for the Ninth Circuit commanding that Court to certify and send to this Court on a day to be designated a full and complete transcript of the record and all proceedings of said Circuit Court of Appeals had in these causes, to the end that the same may be reviewed and determined by this Court; that

the judgment of said Circuit Court of Appeals be reversed as to said patents; and that your petitioners be granted such other and further relief as may seem just and proper.

Dated, San Francisco, California,
September 4, 1940.

Respectfully submitted,

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

THE OPINIONS OF THE COURTS BELOW.

The opinion of the Circuit Court of Appeals appears at 111 F.(2d) 728, and in the record herein at 5 R. 1560-1572, inclusive; the District Court minute orders for entry of decrees for plaintiff appear in the record herein at 1 R. 118 (as to Equity No. 4090-R) and 1 R. 170 (as to Civil Action No. 21,067-R).

JURISDICTION.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the act of February 13, 1925; 28 U.S.C. 347(a); and also by reason of diversity of decision with respect to grave and important rules of patent law.

The decision of the Circuit Court of Appeals for the Ninth Circuit is in conflict with the decisions of this Court and of other Circuit Courts, as seen by the several cases noted supra, pages 14 and 15, in petitioner's assignments of error.

PETITION FOR REHEARING.

A petition for rehearing herein was denied by the Circuit Court of Appeals for the 9th Circuit on June 11, 1940 (5 R. 1574).

STATEMENT.

The controlling facts, together with the questions herein involved and the assignments of error, appear sufficiently set out in the petition.

ARGUMENT.

This case, it is respectfully urged, squarely presents a conflict between corresponding controlling decisions of this Court and the decisions of the various Circuit Courts of Appeals in the United States that have from time to time considered the question of generic chemical claims in patents.

For the first time, as far as we have been able to determine, in the application of the patent statutes, principles of law have been announced which seemingly stand alone, and which, if allowed to stand, effectively determine (a) that the inventor of a new chemical admixture may not claim his invention generically, by claiming chemical ingredients as a **class,** but on the contrary must limit his claims to **specific ingredients** with which he has worked although no members of the class is shown not to be operative for the purpose desired; and (b) that he may not employ terms of function or result in stating quantities or proportion of the ingredients employed.

This Court, as well as the Patent Office tribunals, has long held that in order to claim a **class** of ingredients generically, it is sufficient that the patentee

disclose a reasonable number of members of the class in his specification, **provided** that it is not shown that any member of the class is inoperative to secure the desired result (*Corona v. Dovan,* 276 U.S. 358, 385). This has also been the prevailing ruling of most of the various Circuit Courts of Appeal; and, as recently as November, 1939, less than six months prior to the ruling in the instant case, the Ninth Circuit Court, by a different group of judges from those deciding the instant case, so ruled in *Research Products Co. v. Tretolite,* 106 F.(2d) 530, thereby following what has long been thought to be established law.

I.

THE NINTH CIRCUIT COURT RULE IS AT VARIANCE WITH A UNIFORM LINE OF DECISIONS IN THE SUPREME COURT.

The number of cases in this Court where the subject of the sufficiency or insufficiency of chemical or composition of matter patent claims is discussed is not great; but none of those cases where the matter has been passed upon supports the Ninth Circuit Court of Appeals rule. This Court's position on the subject is not materially different from what it was a hundred years ago, when the first cases came before it. The leading cases, of course, include *The Incandescent Lamp Patent,* 159 U.S. 465; the *Holland Glue* case, 277 U.S. 245; *Corona v. Dovan,* 276 U.S. 358; and the recent case of *General Electric Co. v. Wabash,* 304 U.S. 364.

Since the Court of Appeals based its judgment mainly on the *General Electric* case, we will refer to that case first, to show how it is clearly differentiated from the instant cases.

> *General Electric Co. v. Wabash Co.,* 304 U.S. 364 (overruling the 9th C.C.A., 80 Fed. (2d) 958, on Pacz Patent).*

(In Appendix B hereto we have sufficiently referred to the disclosures and claims of the Lindstaedt and Turnbow patents to show their extent, character and form.)

An analysis of the *General Electric* case and of the claims there in issue and of the facts pertaining thereto, shows conclusively, we respectfully submit, a clear distinction between that case and the present one.

As this Court there indicated (page 368), a typical claim in issue read:

> " '25. A filament for electric incandescent lamps or other devices, composed substantially of tungsten and made up mainly of a number of comparatively large grains of such size and contour as to prevent substantial sagging and offsetting during a normal or commercially useful life for such a lamp or other device.' "

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*It is significant that His Honor Judge Haney, who wrote the opinion in the instant case, also wrote the opinion in the companion case on the Pacz Patent, entitled *Anraku v. General Electric Co.*, 80 F.(2d) 958, which was overruled in the *General Electric v. Wabash* case.

Certiorari was granted in the *General Electric* case, for one reason, no doubt, that the Court of Appeals in the Second Circuit predicated its decision on the testimony of a number of witnesses where neither their testimony nor the substance of the evidence to which their testimony was directed, was before the Court in the *Anraku* case.

This Court, in holding that this claim failed to make a disclosure sufficiently definite to satisfy the requirements of the patent statutes, said (page 369):

> "Patentees may reasonably anticipate that claimed inventions, improvements and discoveries, turning on points so refined as the granular structure of products, require precise descriptions of the new characteristic for which protection is sought. In a limited field the variant must be clearly defined."

And in further criticism of the claim the Court said (page 371):

> "The claim uses **indeterminate adjectives** which describe the function of the grains to the **exclusion of any structural definition,** and thus falls within the condemnation of the doctrine **that a patentee may not broaden his product claims by describing the product in terms of function.** Claim 25 vividly illustrates the vice of a description in terms of function."

FUNCTIONAL CLAIMS PERMISSIBLE.

This Court, however, recognized permissive and beneficial use of functional terms and said (page 371):

> "A limited use of terms of effect or result, which accurately define the essential qualities of a product to **one skilled in the art,** may in some instances be permissible and even desirable, but a characteristic essential to novelty may not be distinguished from the old art solely by its tendency to remedy the problems in the art met by the patent."

THOSE "SKILLED IN THE ART" NOT INFORMED.

Further, the Court said (page 372):

> "And we may doubt whether the language used in Claim 25, taken by itself, conveyed definite meaning to those skilled in the art of incandescent lighting."

In short this Court pointed to the inherent deficiencies of both the claim and the specifications in that neither the claim nor the specification gave the necessary information for those "skilled in the art". That, of course, is fatal in any case. It was fatally defective in the very place where it should have been explicit.

As showing how little the Pacz specification and claim taught, the Court appended this footnote on page 372:

> "There is no showing whether, under established principles in the science, the language indicated grains extending across the width of filament, and if so whether the boundaries were irregular, or regular but not perpendicular to the axis of the filament; or whether the language indicated grains larger than the fine grains of Coolidge's thoriated filament but not large enough to extend across the entire section, and if so what type of boundaries existed.
>
> "Indeed, those merely skilled might have suspected the absence of crystals large enough to extend across the entire section of the filament, in view of the efforts of other patentees to avoid such crystals, * * *."

That the Pacz patent was recognized as unusual is apparent from the quotation at page 372, where this Court said:

> "The Circuit Court of Appeals below suggested that 'in view of the difficulty, if not impossibility, of describing adequately a number of microscopic and heterogeneous shapes of crystals, it may be that Pacz made the best disclosure possible, * * *.'"

CLAIMS TO BE READ WITH REFERENCE TO THE SPECIFICATION.

This Court recognized the well known rule that claims are to be read **by reference to the descriptive parts of the specification.** It was pointed out that the Pacz patent, apparently, did not describe the invention any better in the specification than in the claims, saying (page 373):

> "Assuming that in a proper case a **claim may be upheld by reference to the descriptive part of the specification** in order to give definite content to elements stated in the claim in broad or functional terms, the specification of the Pacz patent does not attempt in any way to describe the filament, except by mention of its coarse-grained quality."

Note: The indefiniteness of the Pacz patent is shown from the very statement in the patent itself (lines 60-62):

> "The probable reason why filaments made according to my invention do not sag is that the structure is comparatively coarse grained."

The astonishing fact is that in the only three respects, viz., **grain size, grain contour and extent of sag,**

in which the product of the patent purported to differ from the prior art, **neither the specification nor the claims defined, nor so much as suggested, any limits.**

That patent set up no standard by which the extent of the claimed monopoly could be made. That was left entirely to experiment based assumedly on the utility of the product. **In other words, according to the patent and to the claim, it was only necessary that the tungsten wire should be commercially useful.** No such extraordinary situation is supported by common sense or legal authority, and it is not surprising that the Court found the claim invalid, because of want of limitations as to size, contour, etc., of the tungsten grains.

We only need to contrast what has been said above with the Lindstaedt claims and the Lindstaedt patent to recognize the points of substantial differentiation.

II.

ESSENTIALS OF A COMPOSITION-OF-MATTER PATENT.

In the *Holland Glue* case, 277 U.S. 245, 254, the Court had before it three claims, which read (page 250):

> "28. A glue comprising cassava carbohydrate rendered semifluid by digestion and having substantially the properties of animal glue.
>
> "30. A wood and fiber glue formed of a starchy carbohydrate or its equivalent by union therewith of about 3 parts or less by weight of water and alkali metal hydroxid.

"31. A wood and fiber glue containing amylaceous material as a base dissolved without acid in about three parts of water or less, and being viscous, semifluid and unjellified."

Analyzing these claims, the Court then said (pages 250-251):

"* * * in point of substance the product claims in suit are for a starch glue which, combined with about three parts or less by weight of water, will have substantially the same properties as animal glue."

In holding these claims deficient in substance the Court said (pages 254-255):

"It was necessary that the Perkins patent, so far as it is a patent of a **composition of matter,** should contain some description of the ingredients entering into the composition which would both define the invention, *Grant v. Raymond,* 6 Pet. 218, 247; *Wood v. Underhill,* 5 How. 1, 5; *Tyler v. Boston,* 7 Wall. 327, 330; *Bene v. Jeantet,* 129 U.S. 683; *Howard v. Detroit Stove Works,* 150 U.S. 164, 167, and carry it beyond the previous development of the art. Had Perkins claimed only a glue made of starch dissolved in three parts of water with an alkali, he would not have advanced beyond the Gerard and Dornemann patents and subsequent practice. * * *

"Perkins' real invention, apart from the combination of his first and second step processes, with which we are not now concerned, was that by the use of a particular kind of starch as an ingredient a new composition of matter was made for which he claimed his patent. * * *

> "As described the starch ingredients fell short of dextrine or soluble starch, but was of lower water absorptivity than petitioner's glue base. The glue made of this ingredient within the specified range was a new product. This was invention of a new composition of matter and was the real contribution Perkins made to the art.
>
> "* * * There can be no description of a composition of matter without some designation of its ingredients."

Turning to the cases cited above, we find that in *Grant v. Raymond* (1832), this Court first authoritatively established the right of a patentee to surrender an issued patent and have it reissued, in case of a **defective or insufficient** specification, so that it might be made sufficient in conformity with the patent statute.

In *Wood v. Underhill et al.* (1847), supra, the patent was for a composition, and the patentee admitted (page 2):

> "that clay which requires the most burning will require the greatest proportion of coal-dust; the exact proportion, therefore, cannot be specified; but, in general, three-fourths of a bushel of coal-dust to one thousand brick will be correct. Some clay may require one-eighth more, and some not exceeding a half-bushel."

It was contended (page 4) that the specification was uncertain and insufficient. Chief Justice Taney, however, **upheld** the patent and, in doing so, gave an indication of the sound rule which for ninety odd

years was thought to be the rule in "composition patent" cases until the Ninth Circuit Court spoke to the contrary in the instant case. Thus Chief Justice Taney said (page 4):

> "The degree of certainty which the law requires is set forth in the act of Congress. The specification must be in such full, clear, and exact terms as to enable any one skilled in the art to which it appertains to compound and use the invention; that is say, to compound and use it without making any experiments of his own."

And continuing (page 5):

> "But when the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent to be void. And the same rule would prevail where it was apparent that the proportions were stated ambiguously and vaguely. For in such cases it would be evident, on the face of the specification, that no one could use the invention without first ascertaining by experiment the exact proportion of the different ingredients required to produce the result intended to be obtained. And if the specification before us was liable to either of these objections the patent would be void, and the instruction given by the Circuit Court undoubtedly right.
>
> "But we do not think this degree of vagueness and uncertainty exists. The patentee gives a certain proportion as a general rule; that is three-fourths of a bushel of coal-dust to one thousand bricks. It is true he also states that clay which

> requires the most burning will require the greatest proportion of coal-dust; and that some clay may require one-eighth more than the proportions given, and some not more than half a bushel instead of three-fourths. The two last-mentioned proportions may, however, be justly considered as exceptions to the rule he has stated; and as applicable to those cases only where the clay has some peculiarity, and differs in quality from that ordinarily employed in making bricks. Indeed, in most compositions of matter, some small difference in the proportions must occasionally be required, since the ingredients proposed to be compounded must sometimes be in some degree superior or inferior to those most commonly used. In this case, however, the general rule is given with entire exactness in its terms; and the notice of the variations, mentioned in the specification, would seem to be designed to guard the brick-maker against mistakes, into which he might fall if his clay was more or less hard to burn than the kind ordinarily employed in the manufacture."

And the Justice says in conclusion that this matter of sufficiency is a question of fact: "* * * a question to be decided by a jury, upon the evidence of **persons skilled in the art** to which the patent appertains."

The Appellate Court here ignored a **complete absence** of any such proofs but held that patent insufficient as a **matter of judicial opinion.**

To paraphrase the argument of Mr. Silliman in *Wood v. Underhill* (page 3): neither the defendant here nor the manufacturer of the infringing product, Kon-Trold Nicotine, had any difficulty in understand-

ing and following the teachings of the Lindstaedt and Turnbow patents "is pretty good evidence that the manufacturer has been able to discover something from plaintiff's specification".

The case of *Tyler v. Boston* (December, 1868), the third case cited above in the *Holland Glue* case, embraced a claim which read (7 Wall. at 328):

> "the compound produced by the combination of the mineral or earthy oils with fusel oil, in the manner and for the purpose substantially as herein set forth; said compound constituting a new manufacture."

The Court at once pointed out the fatal defect residing on the face of the patent, saying (page 330):

> "The patent states that 'the exact quantity of fusel oil which is necessary to produce the most desirable compound must be determined **by experiment'.**" (Blackface by the Court.)

Then the Court drew a clear distinction between cases where an art was developed, and there were those "skilled in such art", and where there was an absence of those skilled in the art, saying:

> "Where a patent is claimed for such a discovery, it should state the component parts of the new manufacture claimed with clearness and precision, and not leave the person attempting to use the discovery to find it out 'by experiment'. The law requires the applicant for a patent-right to deliver a written description of the manner and process of making and compounding his new-discovered compound. The art is new; and therefore persons cannot be presumed to be skilled in

it, or to anticipate the result of chemical combinations of elements not in daily use."

Howard v. Detroit Stove Works, 150 U.S. 164, 167 (1893), was a mechanical patent case, and had to do with the failure of the patentee to give any dimensions to an element known as a "flange", assertedly performing some additional function but failing to differentiate from the prior art, when it was shown that there were already stoves with flanges.

Cochrane v. Badische Anilin & Soda Fabrik, 111 U.S. 293, 310, recognized the negative rule in regard to composition claims: that such composition must be recognized by **description other than by the process for making it.**

The claim there involved reads (page 296):

"Artificial alizarine, produced from anthracine or its derivatives by **either of the methods herein described, or by any other method which will produce a like result.**"

The Court said (page 310):

"Every patent for a product or composition of matter must identify it so that it can be recognized aside from the description of the process for making it, or else nothing can be held to infringe the patent which is not made by that process."

III.

THE NINTH CIRCUIT ERRONEOUSLY GROUPED ALL OF THE CLAIMS OF BOTH PATENTS UNDER THEIR BAN, INSTEAD OF EVALUATING THE CLAIMS SEPARATELY.

"Claims are independent inventions. One may be infringed, others not * * * One claim may be valid, all the rest invalid. * * * In such cases the patent does not stand or fall as a unity." *Leeds & C. Co. v. Victor Talking Machine Co.*, 213 U.S. at 319.

"Each claim is, in effect, a separate and distinct patent." *United Nickel Co. v. Central Pacific R. Co.*, 36 Fed. 186, 188.

IV.

THE APPELLATE COURT'S DECISION TO THE EFFECT THAT A PATENTEE MAY NOT HAVE BROAD CLAIMS AS WELL AS NARROW CLAIMS IN THE SAME PATENT CONTRAVENES LONG-ESTABLISHED PATENT LAW, AS SEEN, FOR INSTANCE, IN ZITTLOZEN v. BOSS, 219 FED. 887, 892 (8 C.C.A.); AND RYDER v. TOWNSEND, 188 FED. 792, 807.

In the last mentioned case it was said:

"And when an inventor makes an invention and in his specifications points out a specific construction he may claim the specific construction and also have a general broad claim, and when this is done, in order to sustain the broader claim, it is not necessary for the patentee to point out in his patent that the specific construction shown is not essential to the invention. The law gives him ample protection whether he does or not. Machine Co. v. Murphy, 97 U.S. 120, 125, 24 L. Ed. 935; Int. T. R. Co. v. Dey et al. (Second Circuit), 142 Fed. 736, 744, 745, 74 C.C.A. 68, 76, 77."

V.

PETITIONERS' CLAIMS NOT OBJECTIONABLE TO THE POINT OF INVALIDITY IN ALLEGEDLY CLAIMING A CLASS, AS AGAINST CLAIMING A SPECIFIC MEMBER OF THE CLASS, IN THE ABSENCE OF A SHOWING THAT AT LEAST SOME MEMBERS OF THE CLASS WOULD NOT WORK.*

The Incandescent Lamp case, 159 U.S. 465.

The case is referred to at this point because it shows at once the failure of the Ninth Circuit to appreciate the **exception** to the rule announced by it, i. e., the absence of any showing that any members of the class or classes announced by Lindstaedt will not work.

This Court in the *Incandescent Lamp* case voiced the rule which it has applied consistently ever since the beginning of the American patent system as a test of the propriety of claims drawn to a chemical class.

In that case the patentee discovered a method of producing an incondescent lamp filament by means of carbonizing paper. The specification of the patent disclosed **only** a method of carbonizing paper and the **single product,** carbonized paper. This Court pointed out the limitations of the disclosure of the specification, saying, quoting the specification:

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*The Ninth Circuit Court in this connection ruled (5 R. 1570-2):

"There are a great many alkaloidal substances, and Lindstaedt and Turnbow, could not, by the simple expedient of claiming a compound of alkaloidal substances and colloidal substances, obtain a monopoly of a countless number of compounds, which could be made from these immense classes of substances. * * *

"An entire **class** of ingredients is specified not specific 'ingredients'. The quantity or proportion of the class is not specified except 'in conveniently functional language'.

"The instant case is one illustrative of the practice followed in many patents. The inventors experimented with and compounded particular alkaloidal substances with particular colloidal substances. Instead of confining their claims to that which they actually discovered, they attempted to monopolize all parasiticides which could be made from the entire class of alkaloidal substances with the entire class of colloidal substances. We think the patent law is not so benevolent, * * *"

> "In the practice of our invention we have made use of carbonized paper, and also wood carbon" (page 467).

Despite the fact that the patentees had disclosed only a single member of the class of fibrous or textile materials, three generic claims had been obtained, two of which were broadly directed to and **claimed the classes of "fibrous or textile materials"** for the purpose of producing the incandescent conductor or filament.

Subsequently the defendant, operating under a disclosure of Thomas Edison, was charged with infringement, and at the trial it was shown that Edison had **experimented with more than 6000 members** of the class of "fibrous or textile materials" and found **all of the members of the class to be inoperative except paper** (as disclosed by the patent), **bamboo, and one other substance.** This Court thereupon ruled that in order to claim a class generally, more than one member of the class must be disclosed in the specification as operative for the purpose, and no member of the class should be shown to be inoperative.

We desire again to call the attention of this Court to the fact that there is **no showing whatever in the instant case that any member of the classes of alkaloids, on the one hand, or substances of colloidal nature, on the other, is inoperative to carry out the teachings of Lindstaedt.**

The Court itself, in the excerpt from the opinion quoted at page 5, supra, indicated its clear under-

standing that there was some general quality* running through the colloid class which made colloids satisfactory for the purpose intended by Lindstaedt.

Therefore, meeting the objection in the *Incandescent Lamp* case, examination of the Lindstaedt specification shows that numerous alkaloids and alkaloidal salts (namely the alkaloids nicotine and coniine and the sulphate and nitrate salts of each) are specifically named in the specification as typical of the class of toxic substances which will act as suitable parasiticides (Lindstaedt 1:2:3-5). With reference to substances of colloidal nature, the specification, as noted above, named a large number of the members of that class, all of which are typical of the protective agents suggested to be employed by the patentee. None of the classes of alkaloids or colloids were shown to be inoperative.

A later application of the same negative rule laid down in the *Incandescent Lamp* case, supra, is found in *Corona v. Dovan,* 276 U.S. 358, from which we quote (page 385):

> "Moreover, the experts show that there are between fifty and one hundred substances which answer this description, of which there is quite a number that are not accelerators at all. Weiss could certainly not claim the entire group of such compounds. He makes no showing that there is any general quality common to disubstituted guanidines which makes them all effect as accelerators.

*Note language p. 475 of *Incandescent Lamp* case.

Claims for their exclusive use cannot therefore be sustained. This is shown by the decision of this Court in the Incandescent Lamp Patent, 159 U.S. 465, where the court said, at page 475:

" 'If, as before observed, there were some general quality, running through the whole fibrous and textile kingdom, which distinguished it from every other, and gave it a particular fitness for the particular purpose, the man who discovered such quality might justly be entitled to a patent; but that is not the case here.' "

VI.

EXTENT OF PROPORTIONS OF CHEMICAL INGREDIENTS NEED NOT BE SET OUT WITH PARTICULARITY WHEN SOME SPECIFIC AND DEFINITE RULE OF DETERMINATION IS MADE AVAILABLE TO THE EXPERT OR MAN SKILLED IN THE ART.

The Appellate Court has insisted here that proportions of ingredients must not only be stated with exactness in the specification, but claimed in the claims, ignoring the fact that the disclosures are addressed to those "skilled in the art" and that the claims are to be read in the light of the specification.

On the other hand this Court (e. g., in *Seabury v. Am Ende,* 152 U.S. 561) as well as other Circuit Courts have held that such details are not essential, where the specifications are otherwise clear to those "skilled in the art" (e. g., *Douglas Pectin Co. v. Armour Co.,* 27 F.(2d) 814, 817 (2 C.C.A.)).

Re Seabury v. Am Ende, 152 U.S. 561, 566-67. The claim there read:

> " 'The borated cotton, being cotton-fibre which is saturated with boracic acid and glycerine, substantially as herein shown and described.' "

In overruling the defense of indefiniteness, the Court said:

> "The first ground of defense relied on is that the patentee has failed to describe his invention in such full, clear, and exact terms as to enable persons reading the description of the invention to construct and use it; and it is contended that the strength of the boracic acid solution is not prescribed, nor the **precise proportion** of glycerine. In considering this objection it must be remembered that the description is **addressed to persons skilled in the art** to which it relates. The solution of boracic acid is referred to, not as anything new, but as an article well known to druggists and physicians, and when the patentee says that he 'prepares a solution of boracic acid in the usual manner', he means as it has formerly and customarily been prepared. When he directs that a small proportion of glycerine shall be added, it is obvious that the quantity of the glycerine is to vary with the amount of cotton and boracic acid used, but that the merits of the invention will not depend on whether, in a given case, a little more or less glycerine is used. Such general directions are common in the arts, as appears in some of the very publications introduced by the defendant to show anticipation.
>
> * * * * * * *
>
> "We, therefore, agree with the court below in thinking that 'an intelligent chemist, setting out

properly to combine the enumerated ingredients into which the cotton is to be immersed, and with which it is to be impregnated, could hardly go astray.' It is also to be observed that neither the defendant, in making the infringing article, nor the several witnesses of eminence in the medical profession, who testified to the practical value of the patented dressing, seem to have had any difficulty in understanding and applying the description contained in the patent."

Re Tilghman v. Proctor, 102 U.S. 707.

The single claim there read (page 709):

"Having now described the nature of my said invention, and the manner of performing the same, I hereby declare that I claim, as of my invention, the manufacturing of fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure."

Despite the fact that neither the "degree of heat" nor the "amount of pressure" were stated, the Court upheld the claims (page 729):

"* * * he claims as his invention **'the manufacturing of fat acids and glycerine and glycerine from fatty bodies by the action of water at a high temperature and pressure.'** The true construction of this claim is to be sought by comparing it, as we have already done, with the context of the specification; * * *" (emphasis by the Court).

And at page 730, after quoting from the specification:

"This is the process which the patentee claims to have invented; and this description of it gives

the proper construction and qualification to the claim."

Re Eibel Co. v. Paper Co., 261 U.S. 45.

That case is recognized as a leading case on the subject of sufficiency of patent claims. There the Circuit Court of Appeals for the Second Circuit had found the claims "too vague because the extent of the factor of pitch is not defined except by the terms 'substantial' and 'high' " (page 65).

This Court overruled the defense and found the claims sufficient for "readers who were skilled in the art of paper making and versed in the use of the Fourdrinier machine".

Further said this court:

"Expressions quite as indefinite as 'high' and 'substantial' in describing an invention or discovery in patent specifications and claims have been recognized by this Court as sufficient" (citing among other cases *Tilghman v. Proctor,* 102 U.S. 707, and *Rubber Co. v. Goodyear,* 9 Wall. 788, 794).

Likewise the rule announced by the Ninth Circuit Appellate Court is at variance with the Courts of other circuits.

Haynes Stellite Co. v. Chesterfield, 22 F.(2d) 635 (6 (C.C.A.),

related to a patent on an alloy of cobalt, chromium and tungsten, in which the Court said (page 636):

"Haynes' specification shows that the invention in its broadest aspect consisted in uniting

cobalt with any two of the metals of the chromium group. This group was said to comprise chromium, tungsten, molybdenum, and uranium. The specification gives particular attention to chromium and tungsten, and claim 8 calls for 'a metal alloy composed of cobalt, chromium, and tungsten in the proportion of from 5 per cent to 60 per cent of tungsten, the remainder of the alloy being cobalt and chromium.' "

In *Douglas Pectin Corp. v. Armour & Co.,* 27 F. (2d) 814 (2 C.C.A.), the claims in question read as follows (page 816):

"2. The process of making jams or conserves consisting in adding to crushed fruit and sugar a concentrated pectous solution, heating the mass **sufficiently** to sterlize it without producing evaporation by prolonged boiling, and subsequently allowing the mass to cool.

"5. The process of making fruit jellies, consisting in adding to fruit juice a **given quantity** of sugar and a **proportional quantity** of concentrated fruit pectins **sufficient** to jellify the mass without prolonged boiling."

In reversing the lower Court and holding the claims sufficient, the Court said, after quoting brief excerpts from the patent (page 817):

"That is a sufficient direction for practical dealing with the ingredients, and teaches any one skilled in the art how to proceed. It is enough that the patent tells us that with concentrated pectin a cold jelly can be made."

The patents there were upheld even though some experimentation or tests might be needed before putting their teachings into practice.

Re Polygon Products Corp. v. Kant-Rust Products Corp., 292 Fed. 569 (3 C.C.A.).

One of the two claims held valid and infringed, as shown by the lower Court's opinion (291 F. 703), was:

> "5 A penetrating adhesion freeing compound for releasing rust films between adherent surfaces, comprising a volatile, penetrating, colloidal solvent having a volatilization retarding colloid in colloidal solution within it, said **colloid having a lubricative character while in colloidal solution in the penetrating solvent, said colloid having also the property of retarding volatilization of the solvent** while in solution therewith."

This Court will note that these are "colloid" claims, in broad language, and definitely specified "characteristics" (i. e., functions), and were held good on the very grounds that the Ninth Circuit Court says are not good.

In upholding the claims that distinguished Appellate Court said (pages 569-70):

> "Of course, the self-penetrating power of oils was always recognized as an aid in unscrewing rusted bolts and nuts, but the fact remained that the physical force of the wrench, tongs, chisel, and hammer was the used method. Into this field of the metal art, as we view it, Abbott, an experienced chemist, in making his invention, brought into practical, commercial, and novel use the **science of colloidal chemistry**, which, though theoretically known for some years, has only of

late been practically applied to the metal and clay arts",

and at page 572:

"Our conclusion in that regard is that its compound and process comprise three elements: First, a penetrant, which, in this case is coal tar oil; second, a **colloid,** which is graphite; and, third, a lubricating oil. These elements, penetrant, **colloid,** and lubricant, each embody the character of the penetrants, **colloids,** and lubricants specified in the claim quoted, and answer to the several descriptions thereof previously quoted herein from the specification, and they all act in and upon and with each other to plasticize and break down the rust binder in joints, nuts, and the like. The objection that some of these elements are not mentioned in the specification carries no weight."

General Electric Co. v. Nitro Tungsten Lamp Co., 266 Fed. 994.

This is on the famous tungsten lamp patent, a typical claim (No. 12) of which read as follows (page 995):

"In an incandescent lamp, the combination of the lamp bulb, a tungsten filament therein, and a gaseous filling, the effective diameter of the filament being **sufficiently large** and the heat conductively of the filling being **sufficiently poor** to permit the lamp to be operated with a filament temperature in excess of that of a vacuum tungsten lamp operating at an efficiency of one watt per candle and with a length of life not less than that of such a lamp" (emphasis ours).

In overruling the defense of indefiniteness the Court said (page 1000):

> "Nor is it perceived that any claim before us is open to the charge of indefiniteness. On the contrary, if such a claim as that originally suggested and above quoted had been allowed, it would surely have been accused of attempting 'to corral the art by the use of comprehensive indefinite terms', and to 'foreclose broadly against the future'. Kintner v. Atlantic, etc., Co. (D.C.), 249 Fed. at page 77. We reassert the statement of Eibel, etc., Co. v. Reminbton, etc., Co., 234 Fed. at page 632, 148 C.C.A. 390, that it is well not to attempt definition, but to **consider the alleged indefiniteness of a claim in the light of the facts of each particular case.** On the present facts, it is clear that it was (1) impossible to define the parts of Langmuir's lamp in millimeters or other dimensional units; and (2) no such effort was necessary to instruct the skilled man how to make the lamp of the patent.
>
> "It was impossible to give exact measurements, because the economic object of the lamp was to diminish the wattage per candle, and dimensions must be proportioned to the designed wattage; i. e., substantially to the size of the lamp—something to be worked out according to rules presumably long familiar to a competent electrical engineer. **It was unnecessary to do more than state the limits of invention in terms of result,*** because the results desired are not functional, and do indicate limits in terms of lamp life and candle

*Apparently the Circuit Court of Appeals for the Ninth Circuit confused "function" and "results accomplished".

The "function" of the colloid was to act as a protective covering; the "result" was to release the poison at the right time.

power which are likewise presumably quite familiar to any competent electrician. When a claim defines achievement in words no broader than the disclosure, and in phrases which, as interpreted by competent workers in the art, tell one how to do what the patentee did, it can rarely be called indefinite."

Re General Electric Co. v. Mallory, 298 F. 579 (2 C.C.A.) (certiorari denied 266 U.S. 609, 69 L. Ed. 466).

As showing both how the Circuit Court of Appeals for the Second Circuit which disagreed with the Ninth Circuit Court in *General Electric v. Wabash,* and how this Court distinguished between claims for similar subject matter, as to definiteness and indefiniteness, we need only refer to the *Mallory* case above, where one of the claims in issue, which was sustained, reads as follows:

"12. In an incandescent lamp, the combination of the lamp bulb, a tungsten filament therein, and a gaseous filling; the effective diameter of the filament being **sufficiently large,** and the heat conductively of the filling being **sufficiently poor,** to permit the lamp to be operated with a filament **temperature in excess** of that of a vacuum tungsten lamp operating at **an efficiency** of one watt per candle and with a **length of life** not less than that of such a lamp."

(For this claim see the so-called *"Nitro-Tungsten* case", 261 Fed. 606, cited in preface to *Mallory* case, page 580.)

In sustaining the claim, and after observing (page 582) that judges sit "not as scientists but as weighers of evidence", Judge Hough went on to say (page 587):

> "There is much rediscussion of filament diameters, but its applicability to the claims in suit centers around the patentee's phrase of 'effective diameter'. What Langmuir saw, and we still think he was the first to see it, was that the filament for a gas-filled lamp must be large, which involved the use of a large wire. But he also saw that it was possible, by coiling, to make a reasonably fine wire (which in other respects was desirable) act like a large wire. Thus he produced a filament of effective size, which on dissection can by certain quibble or play upon words be called a fine wire.
>
> "* * * **The point is that, while critics may point out, and have pointed out, indefiniteness in language, the practical man acquainted with the art has been proven perfectly able presumably to use the patent in making what Langmuir's assignees made first, witness the multitude of infringements productive of litigation. Patents often lend themselves to fine-spun theories; but it is singular how plain they are, if they are worth anything, to the man who wishes to infringe for profit.**"

Re Allen Filter Co. v. Star Metal Mfg. Co. et al., 40 F.(2d) 252 (3 C.C.A.) (certiorari denied, 282 U.S. 848).

In reversing the lower Court and sustaining the claims, the Court said (page 254):

"Nor is patentability defeated because the boundary line between coils coming within the patent and those falling outside it is not marked with equatorial precision. It would have been difficult, if not impossible, to mark it more definitely. It is as fixed and certain as was the boundary in Van Heusen Products v. Earl & Wilson (D.C.), 300 F. 922. It is sufficiently obvious to enable those skilled in the art to locate it. The law requires nothing more. Eibel Co. v. Paper Co., 261 U.S. 45, 43 S. Ct. 322, 67 L. Ed. 523. We think the claims are valid."

THE NINTH CIRCUIT COURT OF APPEALS AT VARIANCE WITH ITS OWN DECISIONS ON THE SAME SUBJECT.

Thus this same Court, only a few months previously, but with a different group of judges, decided almost the contrary of the ruling here, and upheld a chemical composition patent despite the admitted indefiniteness of the patent there, although understandable "to teach the process to those familiar with the art".

We refer to the case of *Research Products Co. v. Tretolite Co.,* 106 F.(2d) 530, 533, where the Ninth Circuit Court of Appeals ruled that the question as to whether or not the descriptions of the chemical agents, given in the patent, to be used, and the manner of use, are sufficiently clear and definite to be understood and applied by **those engaged in the art of organic chemistry,** is a question of fact "to be ascertained by the evidence of experts * * * and that a finding of fact on the matter * * * is entitled to great weight and only to be disturbed if clearly wrong."

The same defenses made here were made there, but overruled, and the patent upheld, although the claims there were no more definite than these claims, and furthermore, the workableness of some of the substances in the claims was more than doubtful.

VII.

THE RULE AS TO FUNCTION.

Thus said this Court in the case of *Holland Furniture Co. v. Perkins Glue Co.,* 277 U.S. 245, 72 L. Ed. 868, 873:

> "* * * the attempt to broaden product claims by describing the product **exclusively** in terms of its use or function is subject to the same vice as is the attempt to describe a patentable device or machine in terms of its function. As a description of the invention it is insufficient and if allowed would extend the monopoly beyond the invention. See Bene v. Jeantet, 129 U.S. 683, 32 L. Ed. 803, 9 Sup. Ct. Rep. 428; Cochrane v. Badische Anilin & Soda Fabrik, 111 U.S. 293, 28 L. Ed. 433, 4 Sup. Ct. Rep. 455; Re Incandescent Lamp Patent, supra; Matheson v. Campbell, 24 C.C.A. 384, 45 U.S. App. 473, 557, 78 Fed. 910; American Adamite Co. v. Mesta Mach. Co. (C.C.9. 3d), 18 Fed. (2d) 538."

We have already shown that this Court has said, in *General Electric v. Wabash,* supra, at page 371, that "a limited use of terms of effect or result which accurately define the essential qualities of a product to one

skilled in the art, may in some instances be permissible and even desirable".

Nevertheless the Ninth Circuit Appellate Court denies any use of functional language in a patent claim.

To embellish the description of a thing by an accurate statement of what it does is always recognized as helpful to the understanding of the thing itself.

It is not that reference in a claim to function bans the claim; but a **functional reference may not be ignored** in claim construction or in passing on infringement. *Thomson Meter Co. v. National Meter Co.*, 106 F. 519; *Computing Scale Co. v. Keystone Co.*, 88 Fed. 788, 791; *McKee v. Noonan*, 86 F.(2d) 986.

VIII.

THE PATENT OFFICE PRACTICE.

The long prevailing practice in the Patent Office as to "generic" and "specific" claims, represented by the claiming of a "class" as distinguished from claiming merely a "species" or an individual member of the class, is something that ought not readily to be upset or ignored.

THE RULE IN CHEMICAL CASES.

Thus we have the following pronouncement of practice in the Court of Customs and Patent Appeals, in *In re Walker*, 70 F.(2d) 1008, at 1011:

> "It is true, as argued by counsel, that appellant is entitled to claim not only the substance

> enumerated by him in his specification, but also their equivalents. However, in cases of this character, involving chemicals and chemical compounds, many of which of course differ radically in their properties, it must appear in the specification, either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that 'the chemicals or chemical combinations included therein were generally capable of accomplishing the desired result.' See In re Ellis, 37 App. D.C. 203; In re Dosselman, 37 App. D.C. 211; In re Langmuir, 62 F.(2d) 93, 20 C.C.P.A. 733."

In *In re Soll,* 97 F.(2d) 623, they made the rule even plainer by showing the negative of it:

> "We think the rule is well settled that in a chemical case where an applicant discloses that one species of a class of chemicals will accomplish a certain purpose without naming any others of the class to which it belongs or without so describing the species and its mode of operation as to call attention to the fact that other members of the class are its equivalents and will perform the same function, he is not entitled to broaden the scope of his disclosed invention by claiming the whole group, even though those skilled in the art may know that in some respects at least the different members of the group are equivalents."

The Board of Appeals decisions are illustrated by the following:

In *Weber,* 2 USPQ 188, the Board said:

> "If applicant pursues his investigations far enough to be able to say that he has tested a reasonable number of the members of a chemical

> class or group and finds that they act in the same way he may be entitled to a claim of such scope as to cover that class."

In *Williams and Neal,* 39 USPQ 125, it was held that a disclosure intended to be generic but mentioning as illustrative a large number of substances from the various classes and groups is as extensive as can reaonably be expected to support generic protection. The claims in that case were held to come within the disclosure.

The Board of Appeals stated the following in *Doan,* 41 USPQ 591:

> "We do not feel that appellant's failure to mention specifically the inert gases other than argon in any way detracts from the generic character of the disclosure. Where an application contains a definite statement with respect to the suitability of a class of materials, we regard it as unimportant that the various materials of the class are not specifically mentioned. If the tenor of an application as a whole is generic, it cannot be made less so by the fact that only one or a few species are specifically mentioned."

Singularly enough, this rule was applied in the instant case involving the Turnbow patent (at the time its application was in interference with that of Lindstaedt), as seen by the File Wrapper, Exhibit 3*b*, Paper #17, when the propriety of claiming the class broadly by disclosure of one representative member thereof was established in a decision by the Examiner of Interferences during the pendency of the Turnbow application.

In sustaining Turnbow's contention, the Examiner said:

> "Counts 5, 6 and 7 (claim 1, 2, and 3 of Lindstaedt) are broader than count 3 in that they are not limited to agar-agar but include other colloidal substances that may be used in place of agar-agar. The Lindstaedt motion to dissolve urges that the Turnbow application does not support these broader claims because it discloses only agar-agar as the colloidal substance. (p. 2.) * * * Counts 5, 6 and 7, however, are limited to colloidal substances, i.e., substances having properties similar to those of agar-agar. Since the function of the agar-agar is merely that of an absorbent for carrying the toxic substance through the upper alimentary tract, it would seem obvious that other similar colloidal materials could be used for this purpose. **Under such conditions the disclosure of one representative member of a group is sufficient to entitle an applicant to claim the group.** Accordingly, the Lindstaedt motion to dissolve as to counts 5, 6 and 7 is denied." (page 3.)

Although priority as to claim 6 (Claim 2 of Lindstaedt) was later conceded to Lindstaedt the important point to be noted is that Turnbow was broad enough in his disclosure to cover not only agar-agar but also, as he expressly stated, products of the nature of agar-agar.

CONCLUSION.

The only guide that the Patent Office has in the granting of patents is that afforded by the statutes and the interpretations of those statutes by this and other Courts of competent jurisdiction.

If the novel rule here laid down by the Ninth Circuit Court of Appeals that generic claims are not permissible in a chemical case is allowed to stand, then and to that extent that decision undermines the whole patent system. This case is of great public interest and importance to the chemical industries, and to the holders of thousands of meritorious chemical patents in general.

If allowed to stand as the law this rule will render void an infinite number of valuable chemical patents, whether already held to be valid or whether as yet unlitigated. The public interest and the interest of commerce and industry, in operating under the patent system, necessarily require that such law, being entirely new and at variance with all precedent, be made final only when all factors and consequences are thoroughly considered.

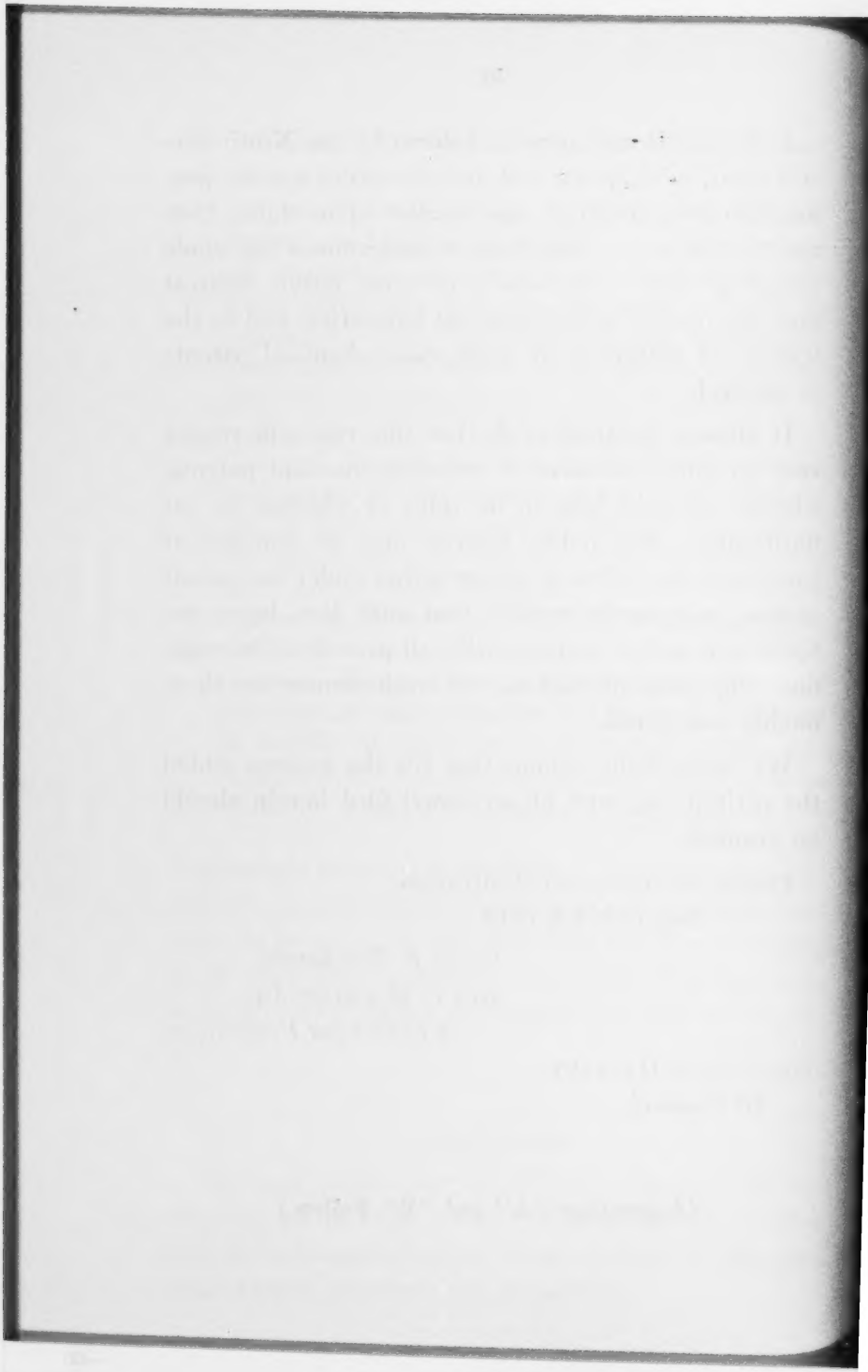
We respectfully submit that for the reasons stated the petition for writ of certiorari filed herein should be granted.

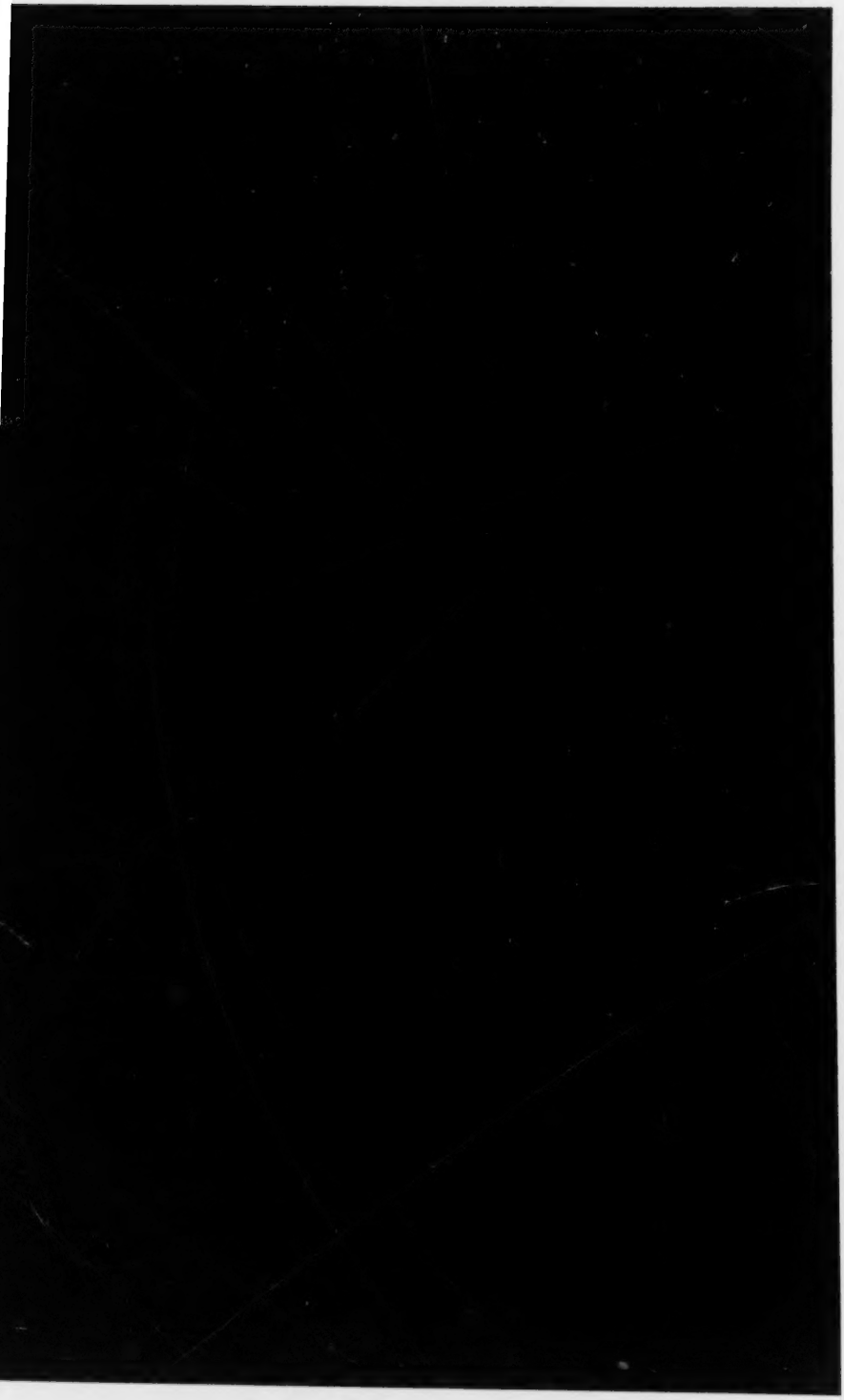
Dated, San Francisco, California,
September 4, 1940.

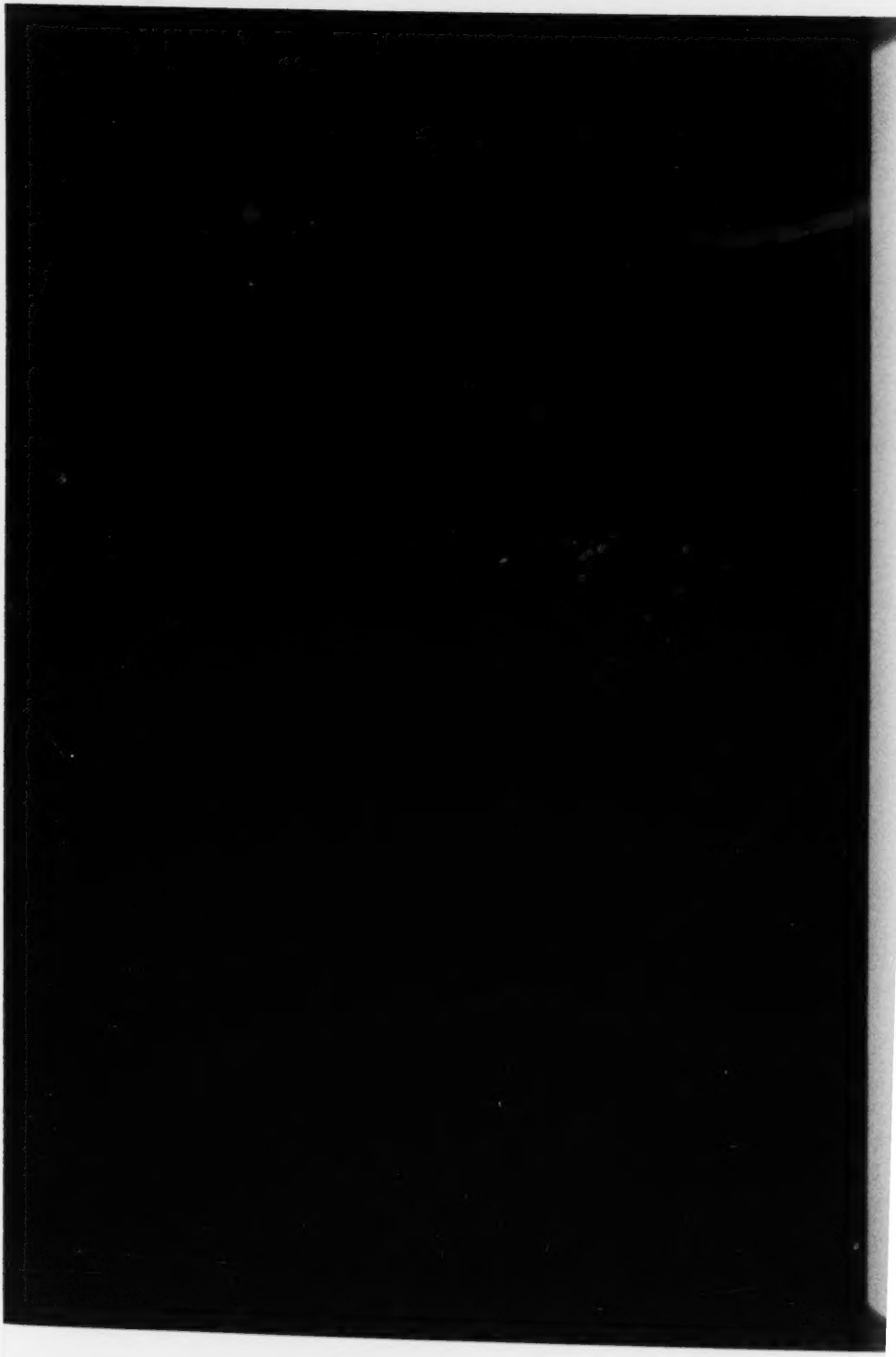
CHAS. E. TOWNSEND,
ROY C. HACKLEY, JR.,
Counsel for Petitioners.

TOWNSEND & HACKLEY,
Of Counsel.

(Appendices "A" and "B" Follow.)







Appendix A

SECTIONS 4886 AND 4888 OF THE PATENT STATUTES.

Sec. 4886 (U. S. C., title 35, Sec. 31): "Any person who has invented or discovered any new and useful art, machine, manufacture, or **composition of matter,** or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Sec. 4888 (U. S. C., title 35, Sec. 33). "Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable **any person skilled in the art or science to which it appertains,** or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall

particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

Appendix B

The record establishes without dissent that the poultry industry in many sections of this country is one of major proportions.

That until the advent of the inventions in suit about a decade ago, one of the great and serious problems of this industry was the widespread presence in poultry flocks of the deadly intestinal roundworm. While numerous attempts to control this problem were made, and many remedies therefor were suggested, nothing successful had been developed; and as a consequence, flock mortality was great and egg production was heavily impaired.

That it was for Mr. Lindstaedt, a skilled chemist in this field, to devise a remedy and a method of controlled application thereof, whereby a suitable toxic substance could be administered to a fowl in such quantity that, although normally it would be lethal to the fowl, it nevertheless would pass harmlessly through the digestive tract until it reached the intestinal tract, where the toxic agent is released and destroys the parasite in the intended manner, at all times leaving the fowl unharmed.

That Mr. Turnbow, another and later skilled worker in the same field, improved on the Lindstaedt disclosures by the discovery of a method whereby the parasiticide, instead of having to be administered to each chicken separately and manually, could be fed to the animals in flocks.

That these discoveries were instantly appreciated in the industry, and were of such tremendous importance and effect in this particular field as to rank them of primary character.

THE LINDSTAEDT PATENT EXPLICIT.

FOR MATERIALS. The Lindstaedt specification defines the preferred **alkaloidal toxic substance** as follows (1:1:20-23):*

> "Alkaloidal substances such as **nicotine, coniine or their salts such as the sulphates,** in sufficient quantity, are effective for destroying parasites such as round worms in animals."

"Colloidal substances" are then defined by the patentee as follows (1:2:6-23):

> "An organic substance of colloidal nature is preferred due to the fact that such substance forms with an alkaloidal substance a product which provides efficacious and thorough destruction of parasites such as round worms. Also, with an organic substance of colloidal nature, relatively large quantities of alkaloidal substance may be administered therewith, without undue shock to the animal. Proteins such as hide-glue, casein powder, peanut meal, pea meal and soy bean meal, are some of the substances of colloidal nature which are satisfactory; substances such as kamala powder, tragacanth powder, powdered Indian gum, powdered agar-agar and powdered shellac,

*In thus referring to quotations from the patents, the first number designates the page of the patent, the second the column, and the third the lines. Thus the above reference signifies "Page 1, column 1, lines 20 to 23".

all of the class of gums and resins, are also satisfactory; also, powdered starch, which is a corbohydrate, and powdered soap, may be used."

For Proportions. The specification and claims call **"a toxic substance in quantity greater than the normally lethal dose"**. A lethal dose is described (1:1:23-33) as follows:

> "If any of these substances (nicotine) are administered alone, it has been found that quantities thereof sufficient to destroy the parasites will also destroy the life of the animal. For example, 5 to 10 milligrams of an alkaloidal substance, such as pure nicotine or nicotine sulphate, is a lethal dose when placed in the mouth of a chicken. Quantities less than this amount are not efficient for the destruction of the parasites. In view of this, the use of these compounds alone is impractical."

The **latitude as to quantity** is illustrated in the patent (1:1:42-50):

> "When the toxic substance is used with any of these substances, a quantity, in excess of that which is normally a lethal dose, may be employed, thus effecting an efficient and thorough destruction of internal parasites. As an example, 70 to 80 milligrams of alkaloidal substances may be administered in this fashion to a chicken, without destroying its life."

Teaching by Example. In order that there be no misunderstanding, the patentee goes on to give a prescription, as follows (1:2:24-29):

> "In preparing the parasiticide, it is preferred to form approximately one gram pellets, containing 70 to 80 milligrams of any of the described alkaloidal substances and about 900 to 1000 milligrams of any of the described substances of colloidal nature."

For corroborative proof that this language was clear and sufficient to the man "skilled in the art" we need only turn to the defendant-respondent's advertising, exemplified by their "Kon-Trold Nicotine" label, Exhibit 7, where appears the following:

> "KON-TROLD NICOTINE is made by a special process which houses the 40% nicotine solution in a chemical compound that controls the release of the nicotine, so that it can be given to poultry with no toxic reaction on the birds. KON-TROLD NICOTINE is not liberated in crop or gizzard of the bird, but is released full strength by the alkaline digestive juices in the intestines."

The balance of the label, of course, directs its attention to the mode of feeding the product to the bird.

Petitioners and respondent both use nicotine sulphate, and both use a colloidal holding substance in combination with nicotine sulphate. Petitioners' and respondent's preparations practically coincide.

LINDSTAEDT CLAIMS.

The Lindstaedt claims in issue are:

> "2. A parasiticide for internal use comprising a toxic substance in quantity greater than the normally lethal dose and a colloidal substance for colloidally holding the toxic substance to protect against the lethal effect of such dose.

"3. A parasiticide for internal use comprising a lethal sized dose of an alkaloidal substance combined into a colloidal substance adapted to colloidally hold the alkaloidal substance and protect against the lethal effect of said alkaloid.

"6. A non-lethal parasiticide for internal administration, for intestinal parasites, comprising the combination of an alkaloid in a dose normally parasiticidal to said parasites and lethal to the subject being treated on ingesting the same alone, and an organic colloid, said organic colloid rendering said dose non-lethal to the subject being treated and leaving it parasiticidal to said parasites.

"8. A non-lethal parasiticide for internal administration, for intestinal parasites, comprising the combination of a nicotine substance in a dose normally parasiticidal to said parisites and lethal to the subject being treated on ingesting the same alone, and an organic colloid, said organic colloid rendering said dose non-lethal to the subject being treated and leaving it parasiticidal to said parasites.

"11. A medicinal compound comprising a toxic substance in quantity greater than the normal lethal does and casein for holding the toxic substance to protect against the lethal effect of such dose.

"12. A medicinal compound comprising nicotine in quantity greater than the normal lethal dose and casein for holding the toxic substance to protect against the lethal effect of such dose."

TURNBOW PATENT NO. 2,091,840.

Turnbow discovered that the broad invention of Lindstaedt could be prepared in the highly advantageous, finely divided form whereby it may be readily administered in the feed of the animals to be treated, for example, to poultry in flocks (Turnbow Patent Exhibit 2, 1:1:49-55, 1:2:1-2). The application of Turnbow as filed was directed to the broad discovery of Lindstaedt, Turnbow going beyond Lindstaedt to disclose the flock treatment or finely divided (comminuted) form of parasiticide or vermifuge. The Turnbow and Lindstaedt patents were co-pending in the United States Patent Office. During this period of co-pendency an interference was declared between the two applicants and was terminated in favor of Lindstaedt, the earlier to file by a matter of fifteen months. Following this the claims remaining in the Turnbow application were limited to a **finely divided** or **comminuted** form of product comprising an active toxic agent, for example, nicotine, and a colloidal holding agent, for example, agar-agar.

TURNBOW CLAIMS.

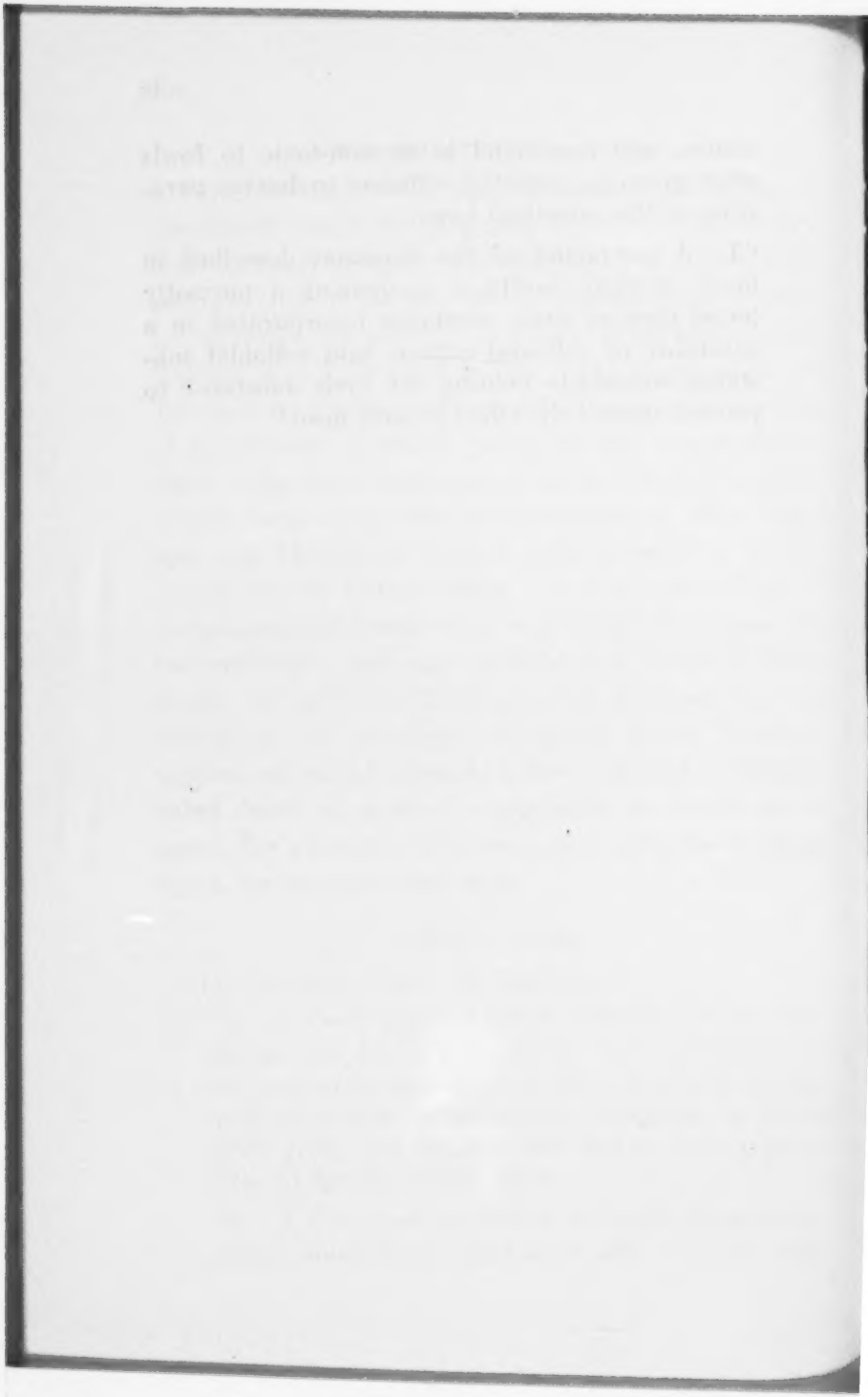
The Turnbow claims in issue are:

"1. A medicinal compound in finely divided condition comprising a normally toxic substance incorporated in agar-agar in proportions to render said substance substantially non-toxic to fowls when given in quantities sufficient to destroy parasites of the intestinal tract.

"2. A medicinal compound in finely divided condition comprising agar-agar and nicotine sub-

stance, said compound being non-toxic to fowls when given in quantities sufficient to destroy parasites of the intestinal tract.

"7. A compound of the character described in finely divided condition comprising a normally lethal dose of toxic substance incorporated in a substance of colloidal nature, said colloidal substance colloidally holding the toxic substance to protect against the effect of such dose."



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CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

October Term, 1940

No. 401

GROVER D. TURNBOW, C. E. GRAY and LEDERLE LABORATORIES, INC., a corporation,

Petitioners,

vs.

FARMERS' COOPERATIVE EXCHANGE, INC.,

Respondent.

BRIEF FOR RESPONDENT.

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Parker & Baird Company, Law Printers, Los Angeles.

TABLE OF AUTHORITIES CITED.

	PAGE
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Wood v. Underhill, 5 How. 1	5

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Respondent.

BRIEF FOR RESPONDENT.

This is the usual patent infringement case.

There is no conflict between the decision herein and the decision of any other court respecting either the validity or scope of either of the patents involved herein.

The petition for certiorari is predicated upon a complete misinterpretation of the decision of the Court of Appeals. Said court held that both patents were anticipated and were void as disclosing no invention. Said court also stated that if either patent could be adjudged to be addressed to any invention, it must be predicated upon a discovery of critical proportions of colloidal material to be used in the composition of matter to prevent the death of the subject to which such composition was ad-

ministered; but that even if it be assumed that there was any such problem as a critical proportion of colloidal material, inasmuch as this must then constitute the "exact point of novelty," then the fact that the quantity or proportions were not set forth in the patent specifications and were included in the claims solely "in conveniently functional language" rendered the patents void under the rule of *General Electric Co. v. Wabash Co.*, 304 U. S. 364, 369. Instead, therefore, of the Court of Appeals decision being in conflict, it is a direct application of the rule of the *General Electric Co. v. Wabash Co.* decision.

The Court of Appeals herein found that the prior Dietrich patent 896,804 [Transcript of Record, Vol. IV., pp. 1209-11]; the Lloyd paper before the American Pharmaceutical Society in 1910 [*Id.*, pp. 1229-49], and the Lloyd patents 1,048,712, 1,300,747, and 1,250,331 [*Id.*, 1517, 1519, 1520], anticipated the two patents in suit unless there was patentable discovery in critical proportions of colloidal material, saying:– "It is clear, therefore, that what, if anything, was novel, was the discovery of how much colloidal material was necessary to carry out the function of preventing the alkaloidal substance from having a lethal effect on the subject to which the product was administered." [Trans. of Record, Vol. V., pp. 1570-71.] "It being apparent, therefore, that the novelty, if any, here resides in the amount of the colloidal substance used, let us examine the claims. We may assume, without so deciding, that the claims sufficiently describe the quantity of the alkaloidal substance. The quantity of colloidal substance is described only as being an amount sufficient to colloidally hold and protect against the lethal effect of the dose. Such is the exact function of the colloidal material." [*Id.*, p. 1571.] The

court held that, "The claims here violate that rule, and are void because 'conveniently functional language at the exact point of novelty' is used. Gen. Electric Co. v. Wabash Co., *supra,* * * *." The specification of neither of the two patents in suit sets forth any critical or exact proportions of colloidal substance to be used.

The petition for certiorari therefore misrepresents and misconstrues the decision of the Court of Appeals. It asserts such decision to be erroneous in two respects: (1) it is charged that the Court of Appeals held the claims to be invalid because "a patentee could not make a generic claim for a class unless he could show affirmatively that every member of that class would work" (Petition for Certiorari, top p. 6), and (2) that an entire patent was void merely where "* * * the proportions of some of such ingredients were delimited in terms of result or function * * *." (Petition for Certiorari p. 6.)

On the contrary, the Court of Appeals points out:– "In this connection, appellees in attempting to distinguish Gen. Electric Co. v. Wabash Co., *supra,* contend that 'each and every of these claims specify the ingredients as well as the quantity or proportion of such ingredients.' *We are unable to agree with that contention.** An entire *class*** of ingredients is specified not specific 'ingredients.' *The quantity or proportion of the class** is not specified except 'in conveniently functional language.'" [Trans. of Record, Vol. V., p. 1572.]

In attempting to construct a conflict in the rule or principle of law applied by the Court of Appeals with

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* Emphasis ours; ** emphasis by the court.

other decisions, petitioner has ignored entirely the next to the last paragraph of the opinion, to wit:—

> "The instant case is one illustrative of the practice followed in many patents. The inventors experimented with and compounded particular alkaloidal substances with particular colloidal substances. Instead of confining their claims to that which they actually discovered, if anything, they attempted to monopolize all parasiticides which could be made from the entire class of alkaloidal substances with the entire class of colloidal substances. We think the patent law is not so benevolent, *and although we do not base our decision on that express ground, we mention it* to refute suggestions that the issuance of a patent offers no protection to a patentee." [*Id.*, p. 1572.] (Emphasis ours.)

The decision of the Court of Appeals is grounded upon its finding that nothing new was disclosed in either of the patents in suit; that neither patent describes in the specification or sets forth in the claims any critical proportion of colloidal material; that the use of alkaloidal substances and of colloidal substances was well known; that the principle of adsorption and absorption of alkaloidal substance by colloidal substance was well known, as well as the chemical fact that where alkaloidal substances are adsorbed or absorbed by colloidal substances, the alkaloidal substance is not released in the digestive tract until the compound passes to the alkaline portion of the tract, the alkalinity of which frees or dissociates

the elements. The Court of Appeals, speaking of the prior Lloyd patent, found therein:

> "* * * the exact theory upon which the patents in issue are based, as shown by the following quotations therefrom:
>
> " 'I have discovered that certain insoluble clays or compounds of magnesium when mixed with certain alkaloids or alkaloidal salts, will adsorb them and prevent their going into solution in water or liquids which are acidulated even to a slight degree, but that in liquids which are alkaline even to a slight degree, such alkaloidal substances will go into solution.
>
> " 'The contents of the stomach are usually slightly acid, whereas the intestines are slightly alkaline. Hence the alkaloidal compounds of my invention will pass through the stomach, without the alkaloids or alkaloidal salts being dissolved, and in the intestines the alkaloids or alkaloidal salts will be dissociated.' " [*Id.* p. 1563.]

The Court of Appeals' opinion is predicated upon an exact following and application of the decisions of this Court in *General Electric Co. v. Wabash Co. (supra)* and *Wood v. Underhill*, 5 How. 1, in which latter decision this Court says:–

> "But when the specification of a new composition of matter gives only the names of the substances which are to be mixed together, *without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent to be void. And*

*the same rule would prevail where it was apparent that the proportions were stated ambiguously and vaguely. For in such cases it would be evident on the face of the specification, that no one could use the invention without first ascertaining, by experiment, the exact proportion of the different ingredients required to produce the result intended to be obtained. * * * And if, from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent."* (Emphasis ours.)

The decision of the Court of Appeals presents no question justifying the grant of the writ of certiorari.

Respectfully submitted,

FREDERICK S. LYON,
Attorney for Respondent.